



1654

TRANSMITTAL FORM

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Total Number of Pages in This Submission

6

Application Number

10/025,225

Filing Date

12/19/01

First Named Inventor

Yu

Group Art Unit

1654

Examiner Name

Roy R. Teller

Attorney Docket Number

LEX-0285-USA

ENCLOSURES (check all that apply)

☐ Fee Transmittal Form

☐ Fee Attached

☒ Amendment/Response

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☐ Information Disclosure Statement

☐ Certified Copy of Priority Document(s)

☐ Response to Missing Parts/Incomplete Application

☐ Response to Missing Parts under 37 CFR 1.52 or 1.53

☐ Assignment Papers (for an Application)

☐ Drawing(s)

☐ Licensing-related Papers

☐ Petition Routing Slip (PTO/SB/69)

☐ To Convert a Provisional Application

☐ Power of Attorney, Revocation Change of Correspondence Address

☐ Terminal Disclaimer

☐ Small Entity Statement

☐ Request of Refund

☐ After Allowance Communication to Group

☐ Appeal Communications to Board of Appeals and Interferences

☐ Appeal Communications to Group (Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

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☒ Additional Enclosure(s) (please identify below):

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Remarks

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name

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Date

February 11, 2004

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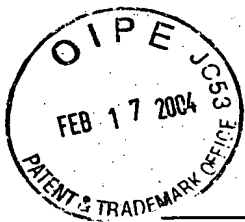
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Yu *et al.*

Group Art Unit: 1654

Application No.: 10/025,225

Examiner: Roy R. Teller

Filed: 12/19/01

Title: Novel Human Protocadherin Proteins and
Polynucleotides Encoding the Same

Attorney Docket No.: LEX-0285-USA

RESPONSE TO OFFICE COMMUNICATION
DATED JANUARY 14, 2004

Commissioner for Patents
Alexandria, VA 22313

Sir:

The Examiner is respectfully requested to accept the following response to the Office Communication mailed January 14, 2004. In the Office Communication it is stated that Applicant's Response to the prior Office Action, a Restriction and Election Requirement (mailed on October 23, 2003), was not fully responsive, allegedly for failure to choose one nucleic acid molecule. Applicants respectfully disagree and point to the last paragraph of Section II of the Response which is reproduced below and stated:

"In the alternative, Applicants provisionally elect with traverse to prosecute the claims of Groups I/II/III which are more properly combined into a single group (as SEQ ID NO:1 encodes SEQ ID NO:2, see above). Applicants further elect, pursuant to 35 U.S.C. § 121, the species of SEQ ID NO: 1 (and the amino acid sequence it encodes, SEQ ID NO:2 for initial examination on the merits. Elected claims 1, 2 and 3 read on the elected species. Applicants understand their species election is being made solely to expedite examination of the application, and that they are entitled to consideration of additional species upon allowance of a generic claim. Applicants reserve the right to refile claims to the non-elected inventions in one or more future applications retaining the priority date of the present case and the earlier cited priority applications."

Applicants have attempted to contact the Examiner on the telephone without success and therefore given the presence of this Election in Applicant's previous Response, Applicants must,

therefore, assume that the Examiner is maintaining the erroneous position that Groups I/II/III represent separate and patently distinct inventions. Applicants can in no way agree with this position. However, assuming that this position is the basis for the allegation that Applicants' Response to Restriction and Election Requirement (mailed October 23, 2003) was not fully responsive, then simply to advance the application to allowance, Applicants Elect to provisionally prosecute with traverse the claim of Group III: which includes Claim 3, drawn to an isolated nucleic molecule, classified in 536 subclass 23.1. Applicants further elect, pursuant to 35 U.S.C. § 121, the species of SEQ ID NO: 1 for initial examination on the merits. Elected claim 3 reads on the elected species. Applicants understand that their species election is being made solely to expedite examination of the application, and that they are entitled to consideration of additional species upon allowance of a generic claim. Applicants reserve the right to refile claims to the non-elected inventions in one or more future applications retaining the priority date of the present case and the earlier cited priority applications. For the record, Applicants note that the isolated nucleic acids described in original claims 1 and 2 also fall within the scope of claim 3 and therefore, as previously presented should properly have been grouped together. In the absence of such proper grouping, Applicants have added dependent claims to better claim the present invention.